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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/595,134

01/16/2007

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MIYOSH0004

3253

24203 7590 11/18/2008  
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EXAMINER

OH, TAYLOR V

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

11/18/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/595,134	<b>Applicant(s)</b> SUZUKI ET AL.	
	<b>Examiner</b> Taylor Victor Oh	<b>Art Unit</b> 1625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/08 &amp; 1/30/07 &amp; 1/16/07</u> .                        | 6) <input type="checkbox"/> Other: _____                          |

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The Status of Claims

Claims 1-19 are pending.

Claims 1-17 are rejected.

Claims 18-19 are withdrawn from consideration.

**DETAILED ACTION**

1. Claims 1-17 are under consideration in this Office Action.

**Priority**

2. It is noted that this application is a 371 of PCT/JP04/12843(09/03/2004), which has a foreign priority document, Japan 2003-311121 (09/03/2003).

**Drawings**

3. None.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1-2,5-6,9-17, the phrases " a general formula" and " a derivative thereof" are recited. These are vague and indefinite because the specification does not elaborate what is meant by each of the terms " general formula" and " a derivative".

Therefore, an appropriate correction is required.

In claims 2 and 6, the phrase " consists essentially of a carboxylic acid represented by the general formula (2) or a derivative thereof " is recited. This is vague and indefinite because the expression of "or " in the Markush group is not close ended, but it is open ended. Therefore, an appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-17 are rejected under 35 U.S.C. 102(b) as being anticipated clearly by Yasunori et al (JP 11-305444).

Yasunori et al discloses the following paragraph(see col. 12 , paragraph #0050):

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[0050]The synthetic example 4 (composition of 5-norbornene 2,3-dicarboxylic acid)

The 5-norbornene 2,3-dicarboxylic anhydride 165g, 100g of ethanol, and the 30% sodium hydroxide solution 400g were prepared, and it stirred at 70 °C for 8 hours. Then, chloride was dropped until it added 100g of toluene to the reaction mass, and it extracted, and pH became 2.0 continuously in the water layer. The precipitated crystal was filtered, and it rinsed, dried and 5-norbornene 2,3-dicarboxylic acid was obtained with 50% of yield. [0051]The synthetic example 5 (composition of 5-norbornene 2,3-dimethyl dicarboxylate)

The 5-norbornene 2,3-dicarboxylic acid 30g obtained by the method of the synthetic example 4 was dissolved in the methanol 50g, the sodium hydroxide solution 50g was added there 50%, and 63 g of dimethyl sulfates were dropped at 20 °C. Then, 5-norbornene 2,3-dimethyl dicarboxylate was obtained with 95% of yield by stirring at a room temperature for 12 hours, and toluene/water extracting a reaction mass, and condensing an organic layer.

This is identical with the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Taylor Victor Oh/  
Primary Examiner, Art Unit 1625  
11/13/08